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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,241	12/14/2001	Douglas B. Quine	F-409	1544
919	7590	10/07/2005		
PITNEY BOWES INC. 35 WATERVIEW DRIVE P.O. BOX 3000 MSC 26-22 SHELTON, CT 06484-8000			EXAMINER ENGLAND, DAVID E	
			ART UNIT 2143	PAPER NUMBER

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/017,241

Applicant(s)

QUINE ET AL.

Examiner

David E. England

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1 – 29 are presented for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 – 5, 8 – 21 and 24 – 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Malik U.S. Publication No. 2002/0065891.

4. Referencing claim 1, as closely interpreted by the Examiner, Malik teaches a method for correcting an e-mail address, the method comprising:

5. parsing a domain portion of the e-mail address, (e.g., ¶ 0031);
6. identifying a format requirement corresponding to the domain portion in a domain name database, (e.g., ¶ 0039 – 0040); and
7. providing a format suggestion based on the identified format, (e.g., ¶ 0039 – 0040).

8. Referencing claim 2, as closely interpreted by the Examiner, Malik teaches parsing an identifier portion of the e-mail address, (e.g., ¶ 0031 & ¶ 0042);

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9. determining whether the identifier portion is consistent with the identified format requirement, (e.g., ¶ 0039 – 0040); and
10. providing an indication of whether the identifier portion is consistent with the identified format requirement, (e.g., ¶ 0039 – 0040).
11. Referencing claim 3, as closely interpreted by the Examiner, Malik teaches the step of determining further comprises:
12. receiving addressee information about an addressee to whom a message is intended at the e-mail address, (e.g., ¶ 0039 – 0040); and
13. determining whether the addressee information is consistent with the identifier portion and the identified format requirement, (e.g., ¶ 0039 – 0040),
14. wherein the addressee information provides information in addition to the e-mail address, (e.g., ¶ 0043-0044 & 0048-0051).
15. Referencing claim 4, as closely interpreted by the Examiner, Malik teaches the addressee information is a name of the addressee, (e.g., ¶ 0042 – 0043).
16. Referencing claim 5, as closely interpreted by the Examiner, Malik teaches the identified format requirement is a function of an addressee's name, and the step of determining further comprises:
17. comparing the identifier portion to a list of known names, (e.g., ¶ 0031 & 0043 – 0045); and

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18. making a determination of whether the identifier portion is consistent with one or more known names under the identified format requirement, (e.g., ¶ 0039 – 0040 & 0043 – 0045).

19. Referencing claim 8, as closely interpreted by the Examiner, Malik teaches the step of:

20. providing a suggested correction that complies with the identified format requirement, (e.g., Abstract).

21. Referencing claim 9, as closely interpreted by the Examiner, Malik teaches receiving addressee information about an addressee to whom a message is intended at the e-mail address, (e.g., ¶ 0035 – 0036); and

22. wherein the step of providing the suggested correction includes generating the suggested correction based on the addressee information, (e.g., Abstract & ¶ 0008),

23. wherein the addressee information provides information in addition to the e-mail address, (e.g., ¶ 0043-0044 & 0048-0051).

24. Referencing claim 10, as closely interpreted by the Examiner, Malik teaches the addressee information is a name of the addressee, (e.g., ¶ 0042).

25. Referencing claim 11, as closely interpreted by the Examiner, Malik teaches the step of gathering the addressee information from the message intended to the addressee, (e.g., ¶ 0035 – 0036).

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26. Referencing claim 12, as closely interpreted by the Examiner, Malik teaches the steps of:
27. determining whether the domain portion complies with domain formulation rules, (e.g., ¶ 0039 – 0040); and
28. providing an indication whether the domain portion complies with domain formulation rules, (e.g., ¶ 0039 – 0040).
29. Referencing claim 14, as closely interpreted by the Examiner, Malik teaches the steps of:
30. comparing the domain portion to a list of known domain names, (e.g., ¶ 0037);
31. if the domain portion is not in the list of known domain names, determining one or more known domain names for which the domain portion may be a misspelling, (e.g., ¶ 0037 & 0049); and
32. providing the one or more known domain names as potential alternative spellings for the domain portion, (e.g., ¶ 0037 & 0049).
33. Referencing claim 15, as closely interpreted by the Examiner, Malik teaches the steps of:
34. identifying a second format requirement corresponding to the one or more known alternative spelling domain names, (e.g., ¶ 0037 & 0049); and
35. providing a preferred alternative spelling for the domain portion based on whether the second format requirement for the one or more known alternative domain spellings is consistent with the identifier portion of the e-mail address, (e.g., ¶ 0037 & 0049).
36. Claims 13, 16 – 21 and 24 – 29 are rejected for similar reasons stated above.

Claim Rejections - 35 USC § 103

37. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

38. Claims 6, 7, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik as applied to claims 1, 2, 5, 16 and 21 above, and in further view of Tafoya et al. (6829607), (hereinafter Tafoya).

39. As per claim 6, as closely interpreted by the Examiner, Malik does not specifically teach the identified format requirement is a function of the addressee's first name and last name, the list of known names includes first names and last names, and the step of comparing the identifier portion to a list of known names further comprises:

40. comparing a first sub-portion of the identifier portion to the list of known first names; and

41. comparing a second sub-portion of the identifier portion to the list of known last names.

Tafoya teaches the identified format requirement is a function of the addressee's first name and last name, the list of known names includes first names and last names, and the step of comparing the identifier portion to a list of known names further comprises:

42. comparing a first sub-portion of the identifier portion to the list of known first names,

(e.g., col. 13, line 46 – col. 14, line 20 & Table 1 & Figure 6); and

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43. comparing a second sub-portion of the identifier portion to the list of known last names, (e.g., col. 13, line 46 – col. 14, line 20 & Table 1 & Figure 6). It would have been obvious to one of ordinary skill in the art, at the time the invention was conceived, to combine Tafoya with Malik because utilizing a sub portion look-up allows efficient email addressing by minimizing users' keystrokes and mouse clicks.

44. Referencing claim 7, as closely interpreted by the Examiner, Malik teaches does not specifically teach teaches the step of making the determination further comprises:

45. utilizing a statistical frequency of the known names to determine a score relating to whether the domain portion is consistent with one or more known names under the identified format requirement, (e.g., ¶ 0035 – 0036), but does not specifically teach utilizing a statistical frequency of the known names to determine a score relating to whether the identifier portion is consistent with one or more known names under the identified format requirement.

46. Tafoya teaches the step of making the determination further comprises:

47. utilizing a statistical frequency of the known names to determine a score relating to whether the identifier portion is consistent with one or more known names under the identified format requirement, (e.g., col. 10, lines 13 – 50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Tafoya with Malik because utilizing a type of score, “weight”, would give the user faster access to email addresses that are utilized more than others and eliminate email addresses that are not utilized often enough from a determination list therefore allowing quicker determination as to which email addresses are “most likely” relevant to the users message.

48. Claims 22 and 23 are rejected for similar reasons as stated above.

Response to Arguments

49. Applicant's arguments filed 07/20/2005 have been fully considered but they are not persuasive.

50. In the Remarks, Applicant argues in substance that Malik does not teach or fairly suggest identifying a format requirement. Even when Malik describes a look-up check for a unique identifier portion of an address, there is no discussion of an abstract format rule applied to addresses at a particular domain.

51. As to part 1, Examiner would first like to draw the Applicant's attention to the claim language of claim 1 in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., an abstract format rule applied to addresses at a particular domain) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

52. Also, Malik inherently teaches identifying a format requirement if the interceptor/parser 21 and checker 22 have to use the domain name to look up information about the domain in the domain name database 20. If Malik didn't know the format requirements of an email address

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then Malik's invention would not be able to perform the functions of finding a domain name in the domain name database.

53. Furthermore, Applicant does not state what specific "requirements" are needed in the claim language, example, is there an "@" symbol, is there any miss-spellings, etc., as seen in claim 1. Therefore, rejection still stands as previously stated.

54. In the Remarks, Applicant argues in substance that Malik does not teach or describe limitations taught in claims 2, 4 and 10.

55. As to part 2, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

56. In the Remarks, Applicant argues in substance that Malik does not teach or suggest using a person's name, such as the first and last names described in the specification.

57. As to part 3, Examiner would like to draw the Applicant's attention to the claim language of claim 5, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., using a person's name, such as the first and last names described in the specification) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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58. What is taught is using an addressee's name. This means that it could be first, last or a nickname that is associated with a user, example BigJohn. Applicant can find the teachings of claim 5 in Malik as cited above.

59. In the Remarks, Applicant argues in substance that Tafoya describes only comparing a single string as input to both first and last names and does not describe comparing two sub-portions of the string and certainly not comparing a first sub-portion to first names and a second sub-portion to last names.

60. As to part 4, Examiner would like to draw the Applicant's attention to the claim language and prior art that can be interpreted into said claim language. If an identifier can be an addressee's first and last name and the first "sub-portion" can be identified as a first name and a second "sub-portion" can be identified as a last name, then if a user decides to type a name the invention of Tafoya will search for first and last names in a database, which are sub-sections, and come up with a first and a second sub-sections in the search. For example, if a user types in "dav", the searches for the first and second sub-section which could be narrowed down to "David" as a first name or "Davis" as a last name. Applicant is reminded that there is no sections of the claim language that state this operation is done independently or together, therefore, the prior art reads on the claim language as broadly interpreted as disclosed possible.

61. In the Remarks, Applicant argues in substance that Malik does not teach the limitations taught in claim 7.

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62. As to part 5, Applicant's arguments with respect to claim 7 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

63. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

64. a. Reilly U.S. Patent No. 6427164 discloses Systems and methods for automatically forwarding electronic mail when the recipient is otherwise unknown.

65. b. Sommerer U.S. Patent No. 6694353 discloses Method and system for automatically updating electronic mail address information within an electronic mail address database.

66. c. Quine et al. U.S. Patent No. 6839738 discloses System and method for cleansing addresses for electronic messages.

67. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

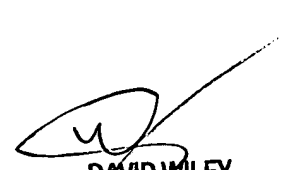
Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 571-272-3912. The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David E. England
Examiner
Art Unit 2143

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